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Ravi Acharya

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EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3694

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/506,434

Applicant(s)

ACHARYA ET AL.

Examiner

Ella Colbert

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 15-17, 21, 55-58, 64, 65 and 68-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-17, 21, 55-58, 64, 65, and 68-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 15-17, 21, 55-58, 64, 65, and 68-76 are pending. Claims 15, 21, and 55 have been amended in this communication filed 12/21/06 entered as Amendment and RCE.
2. The Claim Objections for claims 15, 21, and 55 have been overcome by Applicants' amendment to claims 15, 21, and 55 and is hereby withdrawn.
3. The 35 USC 112 First Paragraph Rejection is maintained for the reasons set forth here below.

### ***Continued Examination Under 37 CFR 1.114***

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/21/06 has been entered.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:  
  
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
6. Claims 15-17, 21, 55-58, 64, 65, and 68-76 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s)

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contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear in the Specification that the ACH and automated banking system do not receive the physical check because according to the Specification on page 10, lines 4-10, the check does go through a clearing process. This process is like the copy of the scanned paper checks that I receive from my bank each month with my bank statement. The deposit of the check amount is an electronic deposit without involving a paper check except for a scanned copy of the paper check and a mark or watermark. This is the reason for the 35 U.S.C. 112, first paragraph rejection being maintained.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 15, 21, and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15, 21, and 55 contain a clause of intended use in the independent claims which renders the claims indefinite. Specifically, claim 15 in claim limitation (a) recites "wherein the bank customer payee is the recipient of a conventional check payable to the bank customer payee" and (b) recites "wherein the transaction data comprises routing number, account number, date written and amount of the conventional check".

The Examiner considers these limitations to only recite what is expected to happen, a desired result, or an intended use. The MPEP discusses a type of limitation in reference to "wherein" clauses. MPEP § 2111.04 states:

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

The MPEP also states in 2172.01:

... a claim which fails to interrelated elements as defined by applicant(s) in the specification may be rejected under 35 USC 112, second paragraph, for failure to point out and distinctly claim the invention.

On page 8 lines 6-12 of the specification discusses the customer being prompted to supply information which a complete set of data may comprise customer identification, customer account number, name of payor, name and routing number of payor's bank, the amount of the check, and image of the check, and other information". However, the claim only recites "transaction data comprises routing number, account number, date written and amount of the conventional check" in 15 (b). The claim limitation should recite "customer identification, customer account number, name of

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payor, name and routing number of payor's bank, the amount of the check, and image of the conventional check" or "customer identification, customer account number, name of payor, name and routing number of payor's bank, the amount of the check, and image of the paper check". Claims 21 and 55 have a similar problem.

Claims 15, 21, and 55 recite "... allowing a bank customer to deposit the value of conventional checks ...".

This recitation is not a positive recitation in the preamble. The definition of "allowing" is to "permit" or "to forbear or neglect to restrain or prevent" or "to make a possibility". The preamble would be better recited as "... allowing a bank customer to deposit the value of conventional checks ...".

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 15, 21, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,464,134) Page.

As per claim 15, Page discloses, A computerized method for allowing a bank customer to deposit the value of conventional checks into a bank account from a location that is remotely situated with respect to a bank comprising: (a) logging a bank customer payee onto an automated banking system through a customer terminal that is remotely situated with respect to a bank and the automated banking system, wherein

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the bank customer payee is the recipient of a conventional check payable to the bank customer payee (col. 3, line 47-col. 4, line 4 and col. 6, lines 7-38- See Summary of the Invention). Customer terminals are located in shopping malls, grocery stores, gas stations, and on-line banking which are remotely located from the bank. It is well known that a customer has to logon to a banking system to conduct any type of transaction. In this case, cashing or depositing a conventional check made to the bank customer. Page further discloses, (b) receiving transaction data that was entered into the customer terminal by the bank customer payee, wherein the transaction data comprises routing number, account number, date written and amount of the conventional check (col. 3, lines 30-47 and col. 6, line 52-col. 7, line 23 –See Summary of the Invention), (c) processing the discrete value of the conventional check for deposit by the automated banking system without physical receipt of the conventional check by the automated banking system (col. 4, lines 13-65, col. 8, lines 4-40 and line 64-col. 9, line 19 -See Summary of the Invention) and (e) receiving by the bank customer a result of the transaction for the conventional check (col. 5, lines 23-51 and col. 9, line 20- col. 10, line 22- See Summary of the Invention).

As per claim 21, claims substantially the same limitations as those for claim 15 and is rejected for the similar rationale as given above for claim 15.

As per claim 55, this independent claim is rejected for the similar rationale as given above for claims 15 and 21.

***Claim Rejections - 35 USC § 103***

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 17, 56- 58, 64, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,464,134) Page in view of Official Notice.

As per claim 17, Page failed to disclose, The method of claim 15 wherein the result of the transaction in step (d) comprises a provisional credit to the bank customer payee's account. Official notice is taken that this is old and well known in the art of bank transactions. It would have been obvious to one having ordinary skill in the art to incorporate in Page a provisional credit to the bank customer payee's account in view of Page's discussion of where the bank check prepared and issued from the issuing terminal is presented for redemption in terms of being deposited or cashed in col. 6, lines 27-col. 7, lines 23. In the art of banking and accounting the payee (the person to whom the written amount on the face of the instrument is paid) when the check is deposited into the payee's account the bank account is credited. This is simply well known accounting procedures of credits and debits. The practice of crediting a bank account is to prevent the bank account of being closed for withdrawal of funds from being overdrawn when making payments to creditors (bill collectors).

As per claim 56, Page discloses, The method of claim 55, wherein the customer terminal comprises a digital image scanner comprising optical recognition software



capable of converting machine printed characters to electronic text (col. 6, line 46-col. 7, line 23). Page did not expressly disclose, optical recognition software capable of converting machine printed characters to electronic text. However, a scanner is capable of converting machine printed characters to electronic text format when a document is scanned. Scanners contain some type of optical recognition software for the conversion of printed characters into electronic text format.

As per claim 57, Page discloses, The method of claim 56, wherein entering transaction data into the customer terminal comprises scanning the checks using the digital image scanner (col. 8, lines 15-40).

As per claim 58, Page did not expressly disclose, The method of claim 55, wherein the result of the transaction in (e) comprises a provisional credit to the associated demand deposit account. Official notice is taken that this is old and well known in the art of bank transactions. It would have been obvious to one having ordinary skill in the art to incorporate in Page a provisional credit to the associated demand deposit account (checking account) in view of Page's discussion of where the bank check prepared and issued from the issuing terminal is presented for redemption in terms of being deposited or cashed in col. 6, lines 27-col. 7, lines 23. In the art of banking and accounting the payee (the person to whom the written amount on the face of the instrument is paid) when the check is deposited into the payee's account the bank account is credited. This is simply well known accounting procedures of credits and debits. The practice of crediting a bank account is to prevent the bank account from

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being closed for over withdrawal of funds when making payments to creditors (bill collectors).

As per claim 64, Page discloses, further comprising (f) optionally subsection each conventional check to one or more actions to prevent redeposit of the conventional check (col. 8, lines 41-63).

As per claim 65, Page discloses, wherein the one or more actions comprise marking each conventional check by human or machine readable ink, physical capture of each conventional check or combinations thereof (col. 8, line 64-col. 9, line 19).

As per claims 68, 71, and 74, Page discloses, wherein entering transaction data into the customer terminal comprises entering transaction data via a magnetic ink character reader or a digital image scanner (col. 9, lines 20-64).

As per claims 69, 73, and 75, Page discloses, wherein the digital image scanner comprises optical recognition software to convert machine printed characters to electronic text (col. 6, lines 55-66).

As per claims 70, 72, and 76, Page discloses, wherein the digital image scanner comprises intelligent character recognition software to convert handwritten characters to electronic text (col. 6, line 66-col. 7, line 23).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to Applicants' disclosure.

Talati et al (US 5,903,878) disclosed initiating a payment via electronic check or a payment transaction for goods and services from the recipient.

Fujimoto (US 6,411,942) disclosed an electronic transaction system and an electronic check including an electronic signature of an issuer and information on an account to be settled.

Adcock et al (US 7,024,385) disclosed an electronic funds transfer system.

### **Inquiries**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

March 27, 2007

  
ELLA COLBERT  
PRIMARY EXAMINER